UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,408	12/17/2004	Peter-Christos Kotar	Q85141	8024

23373 7590 01/07/2008
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER	
NAUROT TON, JOAN	
ART UNIT	**PAPER NUMBER**
2154	

MAIL DATE	DELIVERY MODE
01/07/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/518,408	KOTAR, PETER-CHRISTOS	
	Examiner	Art Unit	
	Joan B. Naurot Ton	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 10/518,408.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/17/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is objected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "the media gateway" on the next to last line of claim 1 lacks antecedent basis and it is unclear as to how many gateways there are in the claim since there is another gateway on lines 3, 5, and 9.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 5 and 6 are rejected because the claimed invention is directed to non-statutory subject matter.

Regarding claim 5: The phrase "a program module" in claim 5 does not recite being stored on hardware (i.e. computer readable storage medium). A program module must be embodied on a computer readable storage medium in order to be statutory. Therefore the claim is software per se.

Regarding claim 6: Claim 6 does disclose the program module being stored but only on a server system. A server system could be viewed as not having hardware.

Therefore the claim is software per se.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saksanen (WO/1997/016007) in view of Egli (EP 1076440A1) and McConnell (US patent 6944150)

Regarding claim 1: Saksanen discloses a method for providing services located in a connectionless packet

network to terminals of a connection oriented communications network, ("a first terminal is connected to a telephone network and a second terminal is connected to a data network, and a connection from the first terminal to the second terminal is set up..." P 8, lines 20-25)

comprising a signalling network for the control of network nodes within said communications network, with a gateway connecting said communications network to said packet network, (" the telecommunication signal is routed to the second terminal connected via the gateway to the data network..." P8, lines 36-37 and P9 line 1)

Saksanen discloses all the limitations as disclosed above except for wherein the following steps are performed: a terminal of the communications network generates a data packet, comprising a communications network address of said gateway in a

header and a service information for a server of the packet network; the terminal transmits said data packet to the communications network over a signalling channel, in the communications network, said header is evaluated and the data packet is forwarded to the gateway over said signalling network and the media gateway extracts the service information and generates a corresponding protocol information to be forwarded to said server over the packet network.

Egli discloses a terminal of the communications network generates a data packet, ("transfer of data from a telecommunication network such as ISDN..." Abstract, lines 1-2, and "ISDN terminals" Col 5, paragraph 0029) comprising a communications network address of said gateway in a header (Col 6, paragraph 0035, lines 27-29, "contains IP addresses and/or ...TCP/UDP port numbers of the source and/or destination gateways GW1 and GW2) and a service information ("signalling data...(the ISDN setup message)" from the user field of the datagram paragraph 0042) the terminal transmits said data packet to the communications network over a signalling channel, ("within a circuit switching network...signalling and control data transferred in the control channel" Col 10,lines 23-24) in the communications network, said header is evaluated and the data packet is forwarded to the gateway over said signalling network (Claim 12, which refers to either GW1 or GW2 as stated in claim 9, in which claim 12 discloses "adding the network address to the header information of said datagram" and Claim 10, in which "exchanged signalling and control data are used...over said packet switching or circuit switching network.") and the media gateway extracts the service information (Claim 12, GW1 performs "extracting the user

data from the data field of the transferred datagrams") and generates a corresponding protocol information to be forwarded over the packet network. (GW2, is over the IP zone as disclosed in Figure 4.)

The general concept of a terminal of the communications network generates a data packet, comprising a communications network address of said gateway in a header and a service information for the packet network; the terminal transmits said data packet to the communications network over a signalling channel, in the communications network, said header is evaluated and the data packet is forwarded to the gateway over said signalling network and the media gateway extracts the service information and generates a corresponding protocol information to be forwarded over the packet network is well known in the art as illustrated by Egli who discloses a terminal of the communications network generates a data packet, comprising a communications network address of said gateway in a header and a service information for a packet network; the terminal transmits said data packet to the communications network over a signalling channel, in the communications network, said header is evaluated and the data packet is forwarded to the gateway over said signalling network and the media gateway extracts the service information and generates a corresponding protocol information to be forwarded over the packet network in a protocol conversion system.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Saksanen to include the use of a terminal of the communications

network generates a data packet, comprising a communications network address of said gateway in a header and a service information for the packet network; the terminal transmits said data packet to the communications network over a signalling channel, in the communications network, said header is evaluated and the data packet is forwarded to the gateway over said signalling network and the media gateway extracts the service information and generates a corresponding protocol information to be forwarded over the packet network in his advantageous method as taught by Egli in order to "allow the transfer of data from a telecommunication network" and for "which the gateway is connected...to the telecommunication network...and the Internet" as stated in the abstract.

McConnell discloses service information for a server and forwarding to a server. (In Col 4, lines 15-20 , McConnell discloses forwarding information in a signaling message to a service agent and for which the service agent layer applies a set of service logic based on information extracted from the packet and Col 4, line 41-43 discloses that the service agent layer may comprise a programmed computer server, and Col 4, line 25 discloses that service agent determines service treatments.)

The general concept of providing service information for a server and forwarding to a server is well known in the art as illustrated by McConnell who discloses a service information for a server and forwarding to a server.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Saksanen to include the use of service information for a server and forwarding to a server in his advantageous method as taught by McConnell in order to

"provide a variety of useful services" in communications networks involving gateways connecting packet networks and circuit switched networks as stated in the abstract, last line.

Regarding claim 2:

Saksanen-Egli-McConnell discloses wherein the data packet is based on a signalling channel protocol message between the terminal TEI and the communications network with the protocol information encapsulated within said message. (Since Egli's terminals are coming from an ISDN network and going over an IP network and the allows the "transparent transfer of the signaling data of the control path over an IP (Internet Protocol) based network," it is inherent that the protocol information is encapsulated within the message. Abstract, lines 1-3 and last three lines.)

The general concept of providing wherein the data packet is based on a signalling channel protocol message between the terminal TEI and the communications network with the protocol information encapsulated within said message is well known in the art as illustrated by Egli who discloses wherein the data packet is based on a signalling channel protocol message between the terminal TEI and the communications network with the protocol information encapsulated within said message.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Saksanen to include the use of wherein the data packet is based on a signalling channel protocol message between the terminal TEI and the

communications network with the protocol information encapsulated within said message in his advantageous method as taught by Egli in order to "allow the transfer of data from a telecommunication network" and for "which the gateway is connected...to the telecommunication network...and the Internet" as stated in the abstract.

Regarding claim 3:

Saksanen-Egli-McConnell discloses a method according to claim 2, wherein the signalling channel protocol

message represents a facility information requesting a certain service feature in the communications network, wherein the service information is encapsulated as facility information element and wherein an information is comprised that indicates, that said service information is to be transparently forwarded to the gateway. (Since Egli's method allows the "transparent transfer of the signaling data of the control path over an IP (Internet Protocol) based network," from an ISDN network to a IP network, abstract, and in which the packet contains the call setup message which is service information is encapsulated in the packet. Paragraph 0041, first line and paragraph 0042, first 5 lines.)

The general concept of providing wherein the signalling channel protocol message represents a facility information requesting a certain service feature in the communications network, wherein the service information is encapsulated as facility information element and wherein an information is comprised that indicates, that said service information is to be transparently forwarded to the gateway is well known in the

art as illustrated by Egli who discloses a wherein the signalling channel protocol message represents a facility information requesting a certain service feature in the communications network, wherein the service information is encapsulated as facility information element and wherein an information is comprised that indicates, that said service information is to be transparently forwarded to the gateway.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Saksanen to include the use of wherein the signalling channel protocol

message represents a facility information requesting a certain service feature in the communications network, wherein the service information is encapsulated as facility information element and wherein an information is comprised that indicates, that said service information is to be transparently forwarded to the gateway in his advantageous method as taught by Egli in order to "allow the transfer of data from a telecommunication network" and for "which the gateway is connected...to the telecommunication network...and the Internet" as stated in the abstract.

Regarding claim 4: Saksanen discloses a terminal of a connection oriented communications network for requesting services located in a connectionless packet network, ("a first terminal is connected to a telephone network and a second terminal is connected to a data network, and a connection from the first terminal to the second terminal is set up..." P 8, lines 20-25) and sending and receiving means for sending and receiving said data packets. (Saksanen discloses "two terminals...such as

telephones, computers or the like which are connected to a telecommunications network for the transmission of telecommunication signals..." between two types of networks with a gateway and for which one network is a packet switching network and the other is connection oriented P 4, lines 10-25)

Saksanen discloses all the limitations except for: generation means, that are realised such ,that a data packet, comprising a network address of a gateway and a service information for a server of the packet network can be generated; processing means, that are realised such, that a data packet received from the communications network is analysed, service information from said data packet is extracted and according to said service information an action can be carried out.

Egli discloses generation means, that are realised such ,that a data packet, comprising a network address of a gateway and a service information for the packet network can be generated, ("transfer of data from a telecommunication network such as ISDN..." Abstract, lines 1-2, and "ISDN terminals" Col 5, paragraph 0029 Col 6, paragraph 0035, lines 27-29, the packet "contains IP addresses and/or ...TCP/UDP port numbers of the source and/or destination gateways GW1 and GW2,
and "signalling data...(the ISDN setup message)" from the user field of the datagram paragraph 0042) processing means, that are realised such, that a data packet received from the communications network is analysed, service information from said data packet is extracted. (Claim 12, GW1 performs "extracting the user data from the data field of the transferred datagrams" in which the user data field has "signalling data...(the ISDN setup message)" in the datagram paragraph 0042).

The general concept of providing generation means, that are realised such ,that a data packet, comprising a network address of a gateway and a service information for the packet network can be generated, and processing means, that are realised such, that a data packet received from the communications network is analysed, service information from said data packet is extracted is well known in the art as illustrated by Egli who discloses generation means, that are realised such ,that a data packet, comprising a network address of a gateway and a service information for the packet network can be generated, and processing means, that are realised such, that a data packet received from the communications network is analysed, service information from said data packet is extracted in a hybrid network.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Saksanen to include the use of providing generation means, that are realised such ,that a data packet, comprising a network address of a gateway and a service information for the packet network can be generated, and processing means, that are realised such, that a data packet received from the communications network is analysed, service information from said data packet is extract in his advantageous method as taught by Egli in order to "allow the transfer of data from a telecommunication network" and for "which the gateway is connected...to the telecommunication network...and the Internet" as stated in the abstract.

McConnell discloses service information for a server and according to said service information an action can be carried out.

(In Col 4, lines 15-20 , McConnell discloses forwarding information in a signaling message to a service agent and for which the service agent layer applies a set of service logic based on information extracted from the packet and Col 4, line 41-43 discloses that the service agent layer may comprise a programmed computer server, and Col 4, line 25 discloses that service agent determines service treatments, and Col 4, lines 25-38 discloses actions such as "pushing content" "rerouting" and "blocking" which are determined by the service agent.)

The general concept of providing service information for a server and according to said service information an action can be carried out is well known in the art as illustrated by McConnell who discloses service information for a server and according to said service information an action can be carried out.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Saksanen to include the use of service information for a server and according to said service information an action can be carried out in his advantageous method as taught by McConnell in order to "provide a variety of useful services" in communications networks involving gateways connecting packet networks and circuit switched networks as stated in the abstract, last line.

Regarding claim 5: Saksanen discloses a program module to be executed in a terminal for the control of

following functions: generation of a data packet, (Saksanen discloses "two terminal devices, such as..computers or the like which are connected to a telecommunications

network for the transmission of telecommunication signals carrying information" in which the computer inherently has memory and a processor on it in order to execute the transmission and generate the packet which carries information P 4, lines 10-25)

Saksanen discloses all the limitations except for comprising a network address of a gateway and a service
information for a server of the packet network, analysing service information out of a received data packet and carrying out an action
according to said service information.

Egli discloses comprising a network address of a gateway (P6, paragraph 0035, lines 27-29, "contains IP addresses and/or ...TCP/UDP port numbers of the source and/or destination gateways GW1 and GW2) and a service information for the packet network, ("signalling data...(the ISDN setup message)" from the user field of the datagram paragraph 0042).

The general concept of providing a network address of a gateway and a service information for a packet network is well known in the art as illustrated by Egli who discloses a network address of a gateway and a service
information for a packet network in a hybrid network.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Saksanen to include the use of a network address of a gateway and a service
information for a packet network in his advantageous method as taught by Egli in order to "allow the transfer of data from a telecommunication network" and for "which the

gateway is connected...to the telecommunication network...and the Internet" as stated in the abstract.

McConnell discloses service information for a server and analysing service information out of a received data packet and carrying out an action according to said service information.

(In Col 4, lines 15-20 , McConnell discloses forwarding information in a signaling message to a service agent and for which the service agent layer applies a set of service logic based on information extracted from the packet and Col 4, line 41-43 discloses that the service agent layer may comprise a programmed computer server, and Col 4, line 25 discloses that service agent determines service treatments, and Col 4, lines 25-38 discloses actions such as "pushing content" "rerouting" and "blocking" which are determined by the service agent.)

The general concept of providing service information for a server and analysing service information out of a received data packet and carrying out an action according to said service information is well known in the art as illustrated by McConnell who discloses service information for a server and analysing service information out of a received data packet and carrying out an action according to said service information.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Saksanen to include the use of service information for a server and analysing service information out of a received data packet and carrying out an action according to said service information in his advantageous method as taught by McConnell in order to "provide a variety of useful services" in communications networks

involving gateways connecting packet networks and circuit switched networks as stated in the abstract, last line.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saksanen, Egli, and McConnell in view of Dowling (US patent 7035932)

Regarding claim 6: Saksenan-Egli-McConnell disclose a program module of claim 5 since the terminal which can be a computer has means to transmit and send packets. (Saksanen discloses "two terminal devices, such as..computers or the like which are connected to a telecommunications network for the transmission of telecommunication signals carrying information" in which the computer inherently has memory and a processor on it in order to execute the transmission and generate the packet which carries information P 4, lines 10-25)

Saksenan-Egli-McConnell discloses all the limitations of claim 6 except for wherein a server system having stored a program module, with downloading means for downloading said program module to a terminal.

Dowling discloses wherein a server system having stored a program module, with downloading means for downloading said program module to a terminal. (Claim 4 discloses "... whereby the coupling of
the resource description language description allows the remote software download server to download to the wireless terminal apparatus only the downloadable software resources for the second executable software module that are not already resident in the wireless terminal apparatus.")

The general concept of providing downloading programs from a server to a terminal is well known in the art as illustrated by Dowling who discloses a server system having stored a program module, with downloading means for downloading said program module to a terminal.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Saksanen to include the use of a server system having stored a program module, with downloading means for downloading said program module to a terminal in his advantageous method as taught by Dowling in order to distribute programs to the necessary terminals.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joan B. Naurot Ton whose telephone number is 571-270-1595. The examiner can normally be reached on M-Th 9 to 6:30 (flex sched) and alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBNT
12/31/2007

JASON CARDONE
SUPERVISORY PATENT EXAMINER